



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

Beth A. Burrous
FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W.,
Suite 500
Washington, DC 20007-5109

COPY MAILED
DEC 15 2005
OFFICE OF PETITIONS

In re Application of :
Ullrich et al. : DECISION ON APPLICATION
Application No. 09/977,260 : FOR
Filed: October 16, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 038602-1260 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER CFR §1.705(b)" filed September 15, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to thirty-five (35) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is thirty-five (35) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 15, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

(PTA) to date is 0 days. The period of adjustment of 184 days for Office delay was reduced by 203 days for applicant delay. On September 15, 2004, applicants timely¹ submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 35 days. Applicants dispute the reduction of 143 days attributed to their delay in responding to the Notice to File Missing Parts of Application mailed November 8, 2001. Applicants state that their response was received in the Office on May 8, 2002, and thus, the delay should have led to a reduction of 89 days, not 143 days.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants are correct. Their response to the Notice to File Missing Parts of Application mailed November 8, 2001, is of record in the application with a date of receipt by the Office of May 8, 2002. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 143 days. However, the response was filed outside of the three-month period under 37 CFR 1.704(b), three months and 89 days later. Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application, but only by 89 days.

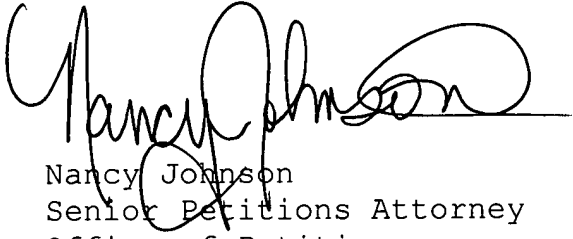
In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is thirty-five (35) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, forwarded to the Office of Patent Publications for issuance of the patent. The patent term adjustment indicated on the patent will include any additional patent term accrued for Office delay in issuing the patent.

¹ PALM records indicate that the Issue Fee payment was also received on September 15, 2004.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a large loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions